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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,329	02/17/2004	Jeff Grady	4185-101-CIP2	1103

23448 7590 01/11/2007
INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

VO, NGUYEN THANH

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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01/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/780,329	GRADY, JEFF	
	Examiner	Art Unit	
	Nguyen T. Vo	2618	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12/4/06 and 12/22/06 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1,3-6,8,9,11,14-22,24,27 and 29-51.
Claim(s) objected to: _____.
Claim(s) rejected: 10,23 and 52-68.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed December 4th, 2006 and December 22nd, 2006 have been fully considered but they are not persuasive.

A. Response to applicant's amendment filed on December 4th, 2006:

Applicant's amendment filed on December 4th, 2006 will not be entered because it raises the issue of new matter. The amendment to the specification on page 8 "Such **control elements 17A, 17B** and frequency indicator 19 may be placed on **any portion of the body 11** including the modular docking unit 16" (emphasis added by examiner) is not supported by the original specification. More specifically, the original specification only discloses "a frequency tuning control" (see original claim 13), **not two control elements 17A and 17B**. The original specification only discloses the control element and frequency indicator placed on the modular docking unit 16, **not on any portion of the body 11**.

Drawing objections:

The drawings were received on December 4th, 2006. These drawings are not approved because it raises the issue of new matter. More specifically, the original specification discloses that the docking unit 16 comprises a frequency tuning control (see original claim 13). However, amended figures 1-3 show **two** frequency tuning control 17A and 17B, and these two frequency control are located outside of the docking unit 16.

Disclosure of Fadell:

Applicant argues that Fadell discloses two different embodiments: a first embodiment requiring a docking station wherein the media device 154 does not have a FM receiver, and a second embodiment requiring a wireless transmitter wherein the media device 154 has a FM receiver. The examiner, however, disagrees. Applicant's attention is directed to figure 2 which discloses a media link 156 between the media player 152 and media device 154. Fadell further discloses at paragraph [0060] that "The media link 156 may be wired **and/or** wireless" (emphasis added by examiner). It means that the media link 156 can be **both wired and wireless in one embodiment**. Therefore, the media device 154 comprises both docking station (for wired link) and FM receiver (for wireless link) in a single embodiment. Accordingly, Fadell does disclose a docking station and a FM receiver as claimed.

Applicant further argues that the sound system (or media device) 370 in figure 12 does not have a radio receiver as claimed. The examiner, however, disagrees. Applicant's attention is directed to Fadell, paragraph [0058] which discloses that the media devices 154 comprise audio equipments such as **boom boxes**. Such boom boxes clearly comprises AM/FM radio receiver. In addition, as discussed above Fadell discloses at paragraph [0060] that "The media link 156 may be wired **and/or** wireless" (emphasis added by examiner). It means that the media link 156 can be **both wired and wireless in one embodiment**. Therefore, the media device 154 comprises both docking station (for wired link) and FM receiver (for wireless link) in a single embodiment. Accordingly, the audio system 370 in figure 12 does comprise a FM receiver as claimed.

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Disclosure of Qureshey:

Applicant argues that Qureshey fails to disclose any “docking cavity” integrated into the body of an audio player for receiving a portable digital media player. In response, Qureshey is relied on by the examiner because it teaches a frequency tuning control and a frequency indicator located on a main body portion, not because it teaches a docking cavity. A docking unit is taught by the primary reference Fadell as discussed above. In addition, since claim 52 does not specifically recite that the modular docking unit comprises the frequency tuning control and frequency indicator (see examiner’s note on page 3 of the Final Action mailed on November 15th, 2006), the combination of Fadell and Qureshey would read on the claimed limitations in claim 52.

Disclosure of Dimenstein:

The examiner’s comments with respect to Fadell and Qureshey are herein incorporated.

Regarding claim 52:

Applicant argues that “Nothing in Fadell teaches or suggests BOTH a docking station and a radio receiver disposed in the same audio player - let alone (A) frequency tuning control and a frequency display element on a main body of the audio player, or (B) at least one speaker selectively operable with an FM receiver and a portable digital media player. That is, even if Fadell were to teach a docking station and radio receiver disposed in the same main body of an audio player, which it does not, Fadell still fails to teach features (A) and (B) as identified immediately above”.

The examiner, however, disagrees. First of all, as discussed above Fadell does teach or suggest BOTH a docking station and a radio receiver disposed in the same audio player. Applicant's attention is directed to figure 2 which discloses a media link 156 between the media player 152 and media device 154. Fadell further discloses at paragraph [0060] that "The media link 156 may be wired **and/or** wireless" (emphasis added by examiner). It means that the media link 156 can be **both wired and wireless in one embodiment**. Therefore, the media device 154 comprises both docking station (for wired link) and FM receiver (for wireless link) in a single embodiment. Accordingly, Fadell does teach or suggest BOTH a docking station and a radio receiver disposed in the same audio player as claimed.

Also as discussed above, since claim 52 does not specifically recite that the modular docking unit comprises the frequency tuning control and frequency indicator (see examiner's note on page 3 of the Final Action mailed on November 15th, 2006), the combination of Fadell and Qureshey would read on the claimed limitations in claim 52 that (A) frequency tuning control and a frequency display element on a main body of the audio player (as taught by Qureshey, figures 13A-13B; paragraphs [0134]-[0137]).

In addition, Fadell discloses at paragraph [0058] that the media devices 154 comprise audio equipments such as home stereos, **boom boxes**. Therefore, the speaker of the audio equipment will play audio signals from the boom boxes when the media player 152 is not used. Accordingly, Fadell does disclose the claimed limitations in claim 52 that (B) at least one speaker selectively operable with an FM receiver and a portable digital media player.

Applicant further argues that Qureshey fails to disclose any "docking cavity adapted to receive a portable digital media player". In response, Qureshey is relied on by the examiner because it teaches a frequency tuning control and a frequency indicator located on a main body portion, not because it teaches a docking cavity. A docking unit is taught by the primary reference Fadell as discussed above. In addition, since claim 52 does not specifically recite that the modular docking unit comprises the frequency tuning control and frequency indicator (see examiner's note on page 3 of the Final Action mailed on November 15th, 2006), the combination of Fadell and Qureshey would read on the claimed limitations in claim 52.

Regarding applicant's discussion of Dimenstein, applicant's attention is directed to the examiner's comments regarding Fadell and Qureshey above for the reasons as to why claim 52 is not allowable over the combination of Fadell and Qureshey.

Applicant further argues that no motivation to combine references has been demonstrated in the record aside from applicant's disclosure. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In addition, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, or motivation to do so found either in the references themselves (in order to allow the user to easily visualize which channel the FM receiver is tuned to, as suggested by Qureshey at figures 13A-13B; paragraphs [0134]-[0137]).

Conclusion:

For the foregoing reasons, the examiner contends that the rejections to claims 52-68 under 35 USC 103(a) are proper.

B. Response to applicant's Supplemental Response and Declaration filed on December 22nd, 2006:

Applicant's Supplemental Response and Declaration filed on December 22nd, 2006 has been entered.

The commercial success provided by Applicant is not found persuasive to overcome the finding of obviousness for the following reasons. Applicant fails to show that the commercial success directly derived from the invention claimed, "in a marketplace wherein the consumer is free to choose on the basis of objective principles" and it must be shown "that such success is not the result of heavy promotion

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or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention.” MPEP 716.03(b). Accordingly, the Applicant bears the burden of supporting the contention of nonobviousness by establishing a nexus between the claimed invention and evidence of commercial success. Also, the evidence provided must be commensurate in scope with the claims.

Additionally, gross sales figures do not show commercial success absent evidence as to market share, or the time period during which the product was sold, or the normally expected sales in the market.

Conclusion:

For the foregoing reasons, the examiner contends that the rejections to claims 52-68 under 35 USC 103(a) are proper.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T. Vo whose telephone number is (571) 272-7901. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nguyen Vo

Nguyen Vo
1-9-2007

NGUYENT.VO
PRIMARY EXAMINER



AUDIO PLAYER ASSEMBLY COMPRISING AN MP3 PLAYER
Applicant: Jeff Grady. Serial No. 10/780,329 Attorney Docket: 4185-101 CIP2
REPLACEMENT SHEET

1 / 3

figures 1, 2, 3 are
NOT approved.
nVo
1-8-2007

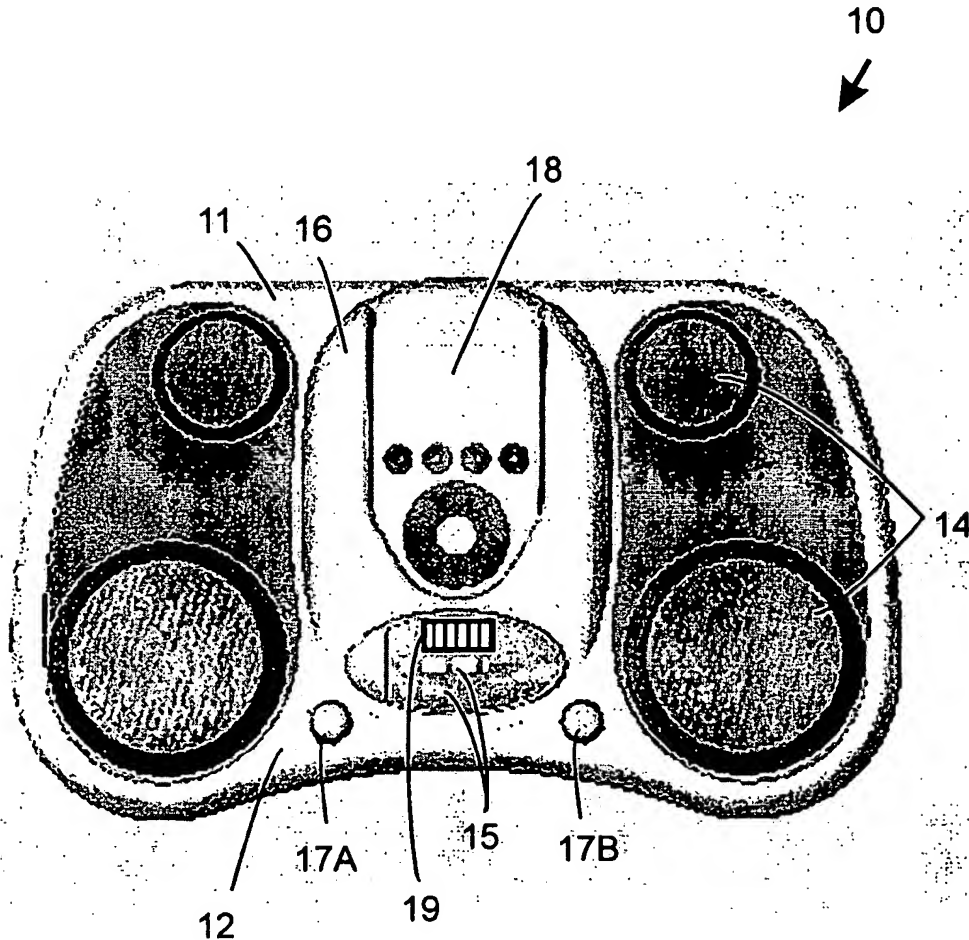


Figure 1

AUDIO PLAYER ASSEMBLY COMPRISING AN MP3 PLAYER
Applicant: Jeff Grady. Serial No. 10/780,329 Attorney Docket: 4185-101 CIP2
REPLACEMENT SHEET

2/3

figures 1, 2, 3 are
NOT approved
nVo
1-8-2007

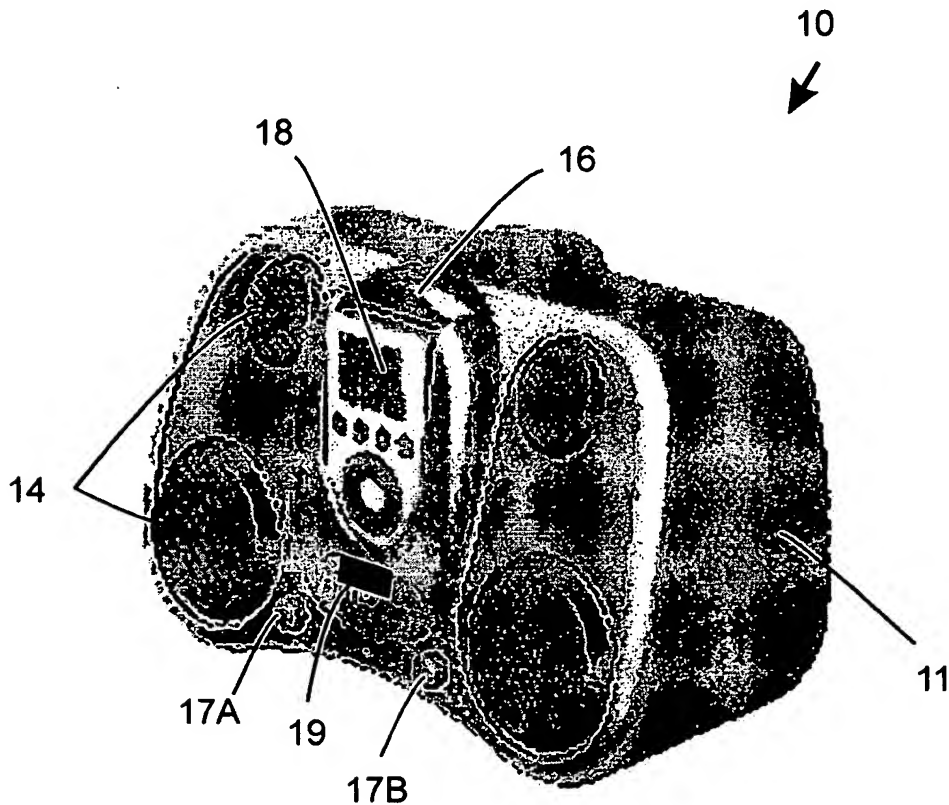


Figure 2

AUDIO PLAYER ASSEMBLY COMPRISING AN MP3 PLAYER
Applicant: Jeff Grady. Serial No. 10/780,329 Attorney Docket: 4185-101 CIP2
REPLACEMENT SHEET

3 / 3

figures 1, 2, 3 are NOT
approved
nVo
1-8-2007

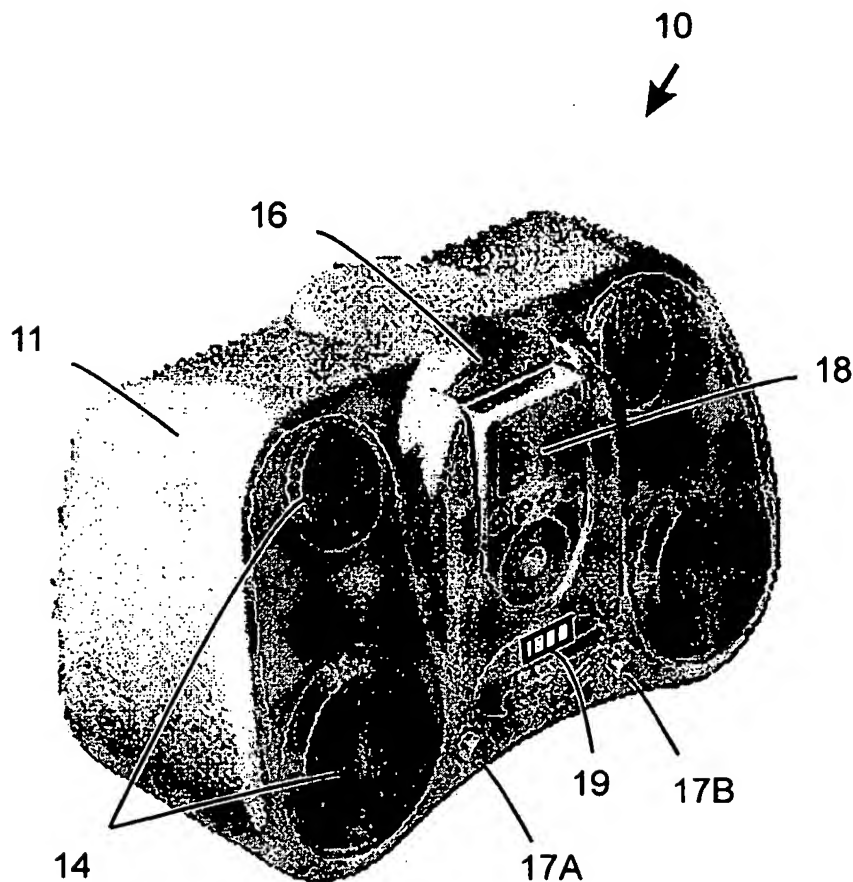


Figure 3